

REMARKS

Claims 1 through 27 are pending in the application.

Examiner has objected to the disclosure because of informalities.

Applicant has amended the disclosure to correct the informalities.

Examiner has rejected claims 1 through 3, 5 through 9, 11 through 14, 16 through 19, 21 through 25 and 27 under 35 U.S.C. § 102(e) as being anticipated by USPN 6,515,988 (Eldridge).

Examiner has rejected claims 4, 10, 15, 20 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Eldridge in view of USPN 6,832,351 (Batres).

Applicant has variously amended the claims. Applicant respectfully traverses the rejection of the claims as amended.

Criteria for rejection of claims under 35 U.S.C. § 102 and 35 U.S.C. § 103

The criteria for a rejection under 35 U.S.C. § 102 has been clearly defined by the courts and confirmed by the U.S. Patent and Trademark Office. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In order to establish a *prima facie* case of obviousness, the prior art references when combined must teach or suggest all the claim limitations.

Below, Applicant points out subject matter within each independent claim that is not disclosed or suggested by the cited art, whether considered alone or in combination. On the basis of this, Applicant believes all the claims are patentable over the cited art.

Discussion of Independent Claim 1

Claim 1 sets out a method for printing from a portable device. Upon a selection to print, the portable device displays a menu devoted to specifying available printing options. In the menu is provided an option to print remote data accessible at a location outside of the portable device by reference to the location outside of the portable device. The option to print remote data being in addition to an option to print data contained within the portable device also provided in the menu. This is not disclosed or suggested by the cited art.

Particularly, Eldridge discloses token-based document transactions. Figure 2 of Eldridge shows a menu for a portable computing device 2. However, the menu shown in Figure 2 of Eldridge is not devoted to specifying available printing options, as set out in claim 1 of the present case. Similarly, the menu shown in Figure 2 of Eldridge does not provide an option to print remote data accessible at a location outside of the portable device by reference to the

location outside of the portable device in addition to an option to print data contained within the portable device also provided in the menu, as set out in claim 1 of the present case. Further, Batres does not disclose or suggest this subject matter set out in claim 1 of the present case that is lacking from Eldridge.

Discussion of Independent Claim 8

Claim 8 sets out a method for printing from a portable device. Upon a selection to print, the portable device displays a menu devoted to specifying available printing options. In the menu is provided an option to use a template to provide standardized formatting to data to be printed. This is not disclosed or suggested by the cited art.

Particularly, Eldridge discloses token-based document transactions. Figure 2 of Eldridge shows a menu for a portable computing device 2. However, the menu shown in Figure 2 of Eldridge is not devoted to specifying available printing options, as set out in claim 8 of the present case. Similarly, the menu shown in Figure 2 of Eldridge does not provide an option to use a template to provide standardized formatting to data to be printed, as set out in claim 8 of the present case. Further, Batres does not disclose or suggest this subject matter set out in claim 8 of the present case that is lacking from Eldridge.

Discussion of Independent Claim 12

Claim 12 sets out a method for printing from a portable device. Upon a selection to print, the portable device displays a menu devoted to specifying available printing options. In the menu is provided an option to print when the portable device is synchronized with a computing system. This is not disclosed or suggested by the cited art.

Particularly, Eldridge discloses token-based document transactions. Figure 2 of Eldridge shows a menu for a portable computing device 2. However, the menu shown in Figure 2 of Eldridge is not devoted to specifying available printing options, as set out in claim 12 of the present case. Similarly, the menu shown in Figure 2 of Eldridge does not provide an option to print when the portable device is synchronized with a computing system, as set out in claim 12 of the present case. Further, Batres does not disclose or suggest this subject matter set out in claim 12 of the present case that is lacking from Eldridge.

Discussion of Independent Claim 13

Claim 13 sets out storage media for storing software. The software, when executed on a portable device, performs a method for printing from a portable device. Upon a selection to print, the portable device displays a menu devoted to specifying available printing options. In the menu is provided an

option to print remote data accessible at a location outside of the portable device by reference to the location outside of the portable device. This is not disclosed or suggested by the cited art.

Particularly, Eldridge discloses token-based document transactions. Figure 2 of Eldridge shows a menu for a portable computing device 2. However, the menu shown in Figure 2 of Eldridge is not devoted to specifying available printing options, as set out in claim 13 of the present case. Similarly, the menu shown in Figure 2 of Eldridge does not provide an option to print remote data accessible at a location outside of the portable device by reference to the location outside of the portable device, as set out in claim 13 of the present case. Further, Batres does not disclose or suggest this subject matter set out in claim 13 of the present case that is lacking from Eldridge.

Discussion of Independent Claim 19

Claim 19 sets out storage media for storing software. The software, when executed on a portable device, performs a method for printing from a portable device. Upon a selection to print, the portable device displays a menu devoted to specifying available printing options. In the menu is provided an option to use a template to provide standardized formatting to data to be printed. This is not disclosed or suggested by the cited art.

Particularly, Eldridge discloses token-based document transactions. Figure 2 of Eldridge shows a menu for a portable computing device 2. However, the menu shown in Figure 2 of Eldridge is not devoted to specifying available printing options, as set out in claim 19 of the present case. Similarly, the menu shown in Figure 2 of Eldridge does not provide an option to use a template to provide standardized formatting to data to be printed, as set out in claim 19 of the present case. Further, Batres does not disclose or suggest this subject matter set out in claim 19 of the present case that is lacking from Eldridge.

Discussion of Independent Claim 22

Claim 22 sets out storage media for storing software. The software, when executed on a portable device, performs a method for printing from a portable device. Upon a selection to print, the portable device displays a menu devoted to specifying available printing options. In the menu is provided an option to print when the portable device is synchronized with a computing system. This is not disclosed or suggested by the cited art.

Particularly, Eldridge discloses token-based document transactions. Figure 2 of Eldridge shows a menu for a portable computing device 2. However, the menu shown in Figure 2 of Eldridge is not devoted to specifying available printing options, as set out in claim 22 of the present case. Similarly, the

menu shown in Figure 2 of Eldridge does not provide an option to print when the portable device is synchronized with a computing system, as set out in claim 22 of the present case. Further, Batres does not disclose or suggest this subject matter set out in claim 22 of the present case that is lacking from Eldridge.

Discussion of Independent Claim 23

Claim 23 sets out a portable device. The portable device includes a printing control. The printing control entity upon recognition of a print selection, displays on the display a menu devoted to specifying available printing options. Provided in the menu is an option to print remote data accessible at a location outside of the portable device by reference to the location outside of the portable device. This is not disclosed or suggested by the cited art.

Particularly, Eldridge discloses token-based document transactions. Figure 2 of Eldridge shows a menu for a portable computing device 2. However, the menu shown in Figure 2 of Eldridge is not devoted to specifying available printing options, as set out in claim 23 of the present case. Similarly, the menu shown in Figure 2 of Eldridge does not provide an option to print remote data accessible at a location outside of the portable device by reference to the location outside of the portable device, as set out in claim 23 of the present

case. Further, Batres does not disclose or suggest this subject matter set out in claim 23 of the present case that is lacking from Eldridge.

Discussion of Independent Claim 25

Claim 25 sets out a portable device. The portable device includes a printing control. The printing control entity upon recognition of a print selection, displays on the display a menu devoted to specifying available printing options. Provided in the menu is an option to use a template to provide standardized formatting to data to be printed. This is not disclosed or suggested by the cited art.

Particularly, Eldridge discloses token-based document transactions. Figure 2 of Eldridge shows a menu for a portable computing device 2. However, the menu shown in Figure 2 of Eldridge is not devoted to specifying available printing options, as set out in claim 25 of the present case. Similarly, the menu shown in Figure 2 of Eldridge does not provide an option to use a template to provide standardized formatting to data to be printed, as set out in claim 25 of the present case. Further, Batres does not disclose or suggest this subject matter set out in claim 25 of the present case that is lacking from Eldridge.

Discussion of Independent Claim 27

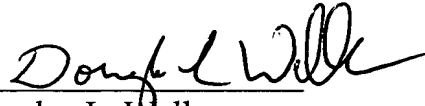
Claim 27 sets out a portable device. The portable device includes a printing control. The printing control entity upon recognition of a print selection, displays on the display a menu devoted to specifying available printing options. Provided in the menu is an option to print when the portable device is synchronized with a computing system, and upon selection of one of the available print options. This is not disclosed or suggested by the cited art.

Particularly, Eldridge discloses token-based document transactions. Figure 2 of Eldridge shows a menu for a portable computing device 2. However, the menu shown in Figure 2 of Eldridge is not devoted to specifying available printing options, as set out in claim 27 of the present case. Similarly, the menu shown in Figure 2 of Eldridge does not provide an option to print when the portable device is synchronized with a computing system, and upon selection of one of the available print options, as set out in claim 27 of the present case. Further, Batres does not disclose or suggest this subject matter set out in claim 27 of the present case that is lacking from Eldridge.

Conclusion

Applicant believes this Amendment has placed the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,
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August 23, 2005
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